

REMARKS

Applicant thanks the Examiner for the very thorough consideration given the present application.

Claims 2, 7 and 10 are now present in this application. Claims 2, 7 and 10 are independent.

By this Amendment, claim 6 is canceled, and claims 7 and 10 are amended. No new matter is involved.

Reconsideration of this application, as amended, is respectfully requested.

Personal Interview

Applicant acknowledges with appreciation the courtesies extended by Examiners Thomas Morrison and David Bollinger to Mr. Robert J. Webster, Applicant's below-named representative, during the personal interview conducted on August 10, 2007. During that interview, agreement was reached that claim 7 was allowable over the applied art, and claim language was discussed which appears to patentably define over the prior art. Therefore, claim 7 has been rewritten in independent form (and claim 6 has been canceled). Thus, the only remaining rejection is that regarding claim 10, which will now be discussed.

Rejection Under 35 U.S.C. § 102

Claim 10 stands rejected under 35 USC § 102(b) as being anticipated by JP 6-179538. This rejection is respectfully traversed.

A prior art reference anticipates the subject matter of a claim when that reference discloses

every feature of the claimed invention, either explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed Cir. 1997). While, of course, it is possible that it is inherent in the operation of the prior art device that a particular element operates as theorized by the Examiner, inherency may not be established by probabilities or possibilities. What is inherent, must necessarily be disclosed. In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) and In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

If the PTO fails to meet this burden, then the applicant is entitled to the patent. However, when a *prima facie* case is made, the burden shifts to the applicant to come forward with evidence and/or argument supporting patentability. Patentability vel non is then determined on the entirety of the record, by a preponderance of evidence and weight of argument, *Id.*

Moreover, as stated in MPEP § 707.07(d), where a claim is refused for any reason relating to the merits thereof it should be "rejected" and the ground of rejection fully and clearly stated.

Additionally, findings of fact and conclusions of law by the USPTO must be made in accordance with the Administrative Procedure Act, 5 U.S.C. § 706(A), (E) (1994). Zurko v. Dickinson, 527 U.S. 150, 158, 119 S.Ct. 1816, 1821, 50 USPQ2d 1930, 1934 (1999).

Applicant respectfully submits that Kasahara does not disclose the subject matter recited in claim 10, as amended. Claim 10, as amended, positively recites a combination of features including first separating rollers arranged with overlaps to the conveying rollers to separate the

media one by one, and second separating rollers arranged to face an outer surface of the conveying rollers with gaps between the second separating rollers and the conveying rollers, and which form and maintain a gap with the facing outer surfaces of the conveying rollers greater than the thickness of the media for generating a frictional force to the media regardless of the stiffness of the media;

Support for this language is found in Applicant's originally filed disclosure, for example in Figs. 6 and 7, and is discussed, for example, on pages 9-11.

As discussed during the aforementioned interview, it would appear that JP 6—179538 does not disclose maintaining a gap between the facing separating rollers and conveying rollers regardless of the stiffness of the media, as recited.

Accordingly, claim 10 is not anticipated by JP 6-179538.

Reconsideration and withdrawal of this rejection of claim 10 are respectfully requested.

Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Allowed Claim

Applicant acknowledges with appreciation that claim 2 has been allowed.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46, 472, at (703) 205-8000, in the Washington, D.C. area.

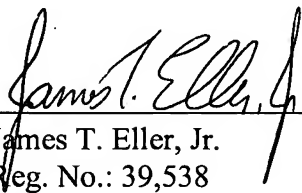
Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Date: August 23, 2007

Respectfully submitted,

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